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In re Application of
Diego Dayan et al.
Application No. 10/662,168
Filed: September 10, 2003
Attorney Docket No. 02875/100H491-US1

OFFICE OF PETITIONS

: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(a)

This decision is in response to the petitions filed November 1, 2004, under 37 CFR 1.47(a) and 37 CFR 1.137(b), in response to the Notice to of Incomplete Reply, mailed August 2, 2004.

The petition under 37 CFR 1.137(b) is **DISMISSED**.
The petition under 37 CFR 1.47(a) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)". This is not a final agency decision.

The above-identified application was filed on September 10, 2003, naming Diego Dayan, Abel A. Godon, Jorge A. Estevez, Federico Alavarez, Ivan S. Entel and Samuel S. Tenembaum, but without a signed declaration. Accordingly, on December 3, 2003, a "Notice To File Missing Parts of Application" was mailed, requiring *inter alia* a properly executed oath or declaration. A response to the Notice was filed July 6, 2004 with a request for a five month extension of time. While the response included an oath or declaration, the oath or declaration was not executed by joint inventor Diego Dayan and thus since the time allowable for response had elapsed, the application became abandoned.

The present petitions seek revival under 37 CFR 1.137(b) and status under 37 CFR 1.47(a). Petitioner claims that they have mailed the declaration to Mr. Dayan and spoken to him regarding the declaration but that he has not returned the same, thus by his actions, Mr. Dayan has refused to cooperate with the filing of the instant application.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and
- (4) a statement of the last known address of the non-signing inventor.

The present petition lacks item (1).

In regards to item (1), petitioners have not provided sufficient proof that a copy of the application (specification, including claims, drawings, if any, and the declaration) was sent to the non-signing inventor. The statement made by Silvina Pirraglia reveal that the declaration was sent to Mr. Dayan, but don't indicate that the complete application was ever sent to Mr. Dayan. Thus, there is no evidence to show that Mr. Dayan had the benefit of reviewing the application.

Petitioners may show proof that a copy of the application was sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the application papers to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Likewise, before a *bona fide* refusal can be shown, the non-signing inventor must have been given an opportunity to review the application. Therefore, petitioners must show proof that the non-signing inventor refuses to sign the declaration after being sent or given a copy of the application papers. If there is a written refusal, petitioners should submit a copy of that refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

- (2) the petition fee as set forth in 37 CFR 1.17(m);
- (3) a statement that the entire delay in filing the required reply from the due date

for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may required additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

Since the petition under 37 CFR 1.47(a), also filed November 1, 2004, is dismissed, the required reply under 37 CFR 1.137(b), item (1), is also lacking.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 872-9306
Office of Petitions

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.


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